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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CHARLES N.J. RUGGIERO, ESQ.
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
ONE LANDMARK SQUARE, 10th FLOOR
STAMFORD, CT 06901-2682

EXAMINER

KIDWELL, MICHELE M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,657

Applicant(s)

JACKSON ET AL.

Examiner

Michele Kidwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,7,13,16-18,23 and 48-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7,13,16-18,23 and 48-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2004 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3 – 4, 6 – 7, 13, 16 – 18, 23 and 48 – 57 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an adhesive backed label being detachably connected to a release liner, does not reasonably provide enablement for a second surface of a three-dimensional tape being connected to an adhesive backed label which is in turn detachably connected to a release liner. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

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The applicant has amended claim 1 to recite that the second surface of the three dimensional tape is to an adhesive backed label and refers to pages 9 and 10 of the specification to provide support for this amendment. However, the instant application recites that the tape may be supplied as the adhesive backed label on a release liner that may be discarded after use.

Claims 1, 3 – 4, 6 – 7, 13, 16 – 18, 23 and 48 – 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With reference to claim 1, the applicant claims a tape, an adhesive backed label and a release liner. However, the specification provides support for an adhesive backed label on a release liner. It is unclear if the applicant intends to claim a three layered structure (i.e., tape, label and release liner) or a two layered structure (label and release liner). Clarification and/or correction are required.

For examination purposes, the examiner interprets the claim language in light of the specification, which describes the finger grip tape as the adhesive backed label that is detachably connected to a release liner (page 9, line 34 to page 10, line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 – 4, 6 – 7, 13, 23, 48 – 54 and 56 – 57 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,575,169) and further in view of Reeves et al. (US 5,491,015).

With reference to claim 1, Voss discloses an applicator barrel having an outer surface and a three-dimensional tape connectable to a portion of an outer surface, the tape including a first surface and a second surface opposite the first surface, the first surface having formed thereon at least one integrally formed gripping structure, and a second surface as set forth in figures 2 – 7.

The difference between Voss and claim 1 is the provision that the three dimensional tape is connected to an adhesive backed label detachably connected to a release liner.

Reeves et al. (hereinafter “Reeves”) discloses a three-dimensional tape connectable to a portion of an outer surface, the tape including a first surface and a second surface opposite the first surface (figure 1), the first surface having formed thereon at least one integrally formed gripping structure (22), and the second surface being connected to an adhesive backed label (16) detachably connected to a release liner (20) as set forth in col. 5, lines 38 – 42 and in figure 1.

It would have been obvious to one of ordinary skill in the art to provide the three dimensional tape of Reeves in combination with the applicator barrel of Voss because Voss teaches the use of a three dimensional tape with an applicator barrel and the substitution of one three dimensional tape for another includes only a level of ordinary skill in the art.

Likewise, the three dimensional tape of Reeves is suitable for any article adapted for interaction with hands or feet (col. 2, lines 62 – 63) and exhibits more uniform and more consistent slip control properties (col. 3, lines 1 – 3). Further, the use of release liners with adhesive backed layers is well known in the art to allow for sterility of the structure prior to use.

With reference to claim 3, Voss teaches at least one gripping structure extending inwardly from the first surface as set forth in figure 5.

As to claim 4, Voss discloses a plurality of gripping structures in figures 2 – 7.

With respect to claims 6 and 7, the examiner considers the protrusions (22) alone of Reeves to form the diamond pattern, and the protrusions along with the underlying portion of the layer (12) to form the box-diamond combination pattern as claimed.

With respect to claims 13 and 23, Voss does not specifically disclose that the tape is formed of polypropylene (or those of claim 23) even though Voss does disclose that the tape is formed from plastic materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the plastic tape of Voss from polypropylene (or those of claim 23) because polypropylene (and those of claim 23) is widely used plastic material that is used to form tampon applicators (and related components). The choice of what specific plastic material is used to make the tape from will not materially affect how the tape operates or functions so based on the fact that Voss discloses that the tape can be plastic, reciting that the tape is made from polypropylene is not sufficient to patentably distinguish from Voss.

With reference to claims 48 – 50, 54 and 57, see the figures of Voss.

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As to claims 51 – 53, the examiner contends that the claimed limitations are obvious matters of design choice that do not patentably distinguish the claimed invention from the prior art.

As to claim 56, the examiner considers the claimed limitation to be inherent in Voss. This is because the finger gripping structure is being provided for the reason that the outer tube can be slippery. The finger grip will then assist in gripping. The coefficient of friction for the coated layer of the barrel will inherently be less than the coefficient of friction for the gripping structure.

Claims 1, 3 – 4, 6 – 7, 13, 23, 48 – 54 and 56 – 57 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,575,169).

With reference to claim 1, Voss discloses an applicator barrel having an outer surface and a three-dimensional tape connectable to a portion of an outer surface, the tape including a first surface and a second surface opposite the first surface, the first surface having formed thereon at least one integrally formed gripping structure, and a second surface as set forth in figures 2 – 7.

The difference between Voss and claim 1 is the provision that the three dimensional tape is detachably connected to a release liner.

It would have been obvious to one of ordinary skill in the art to provide the tape of Voss with a release liner since it is well known in the art that the use of a release liner is desirable because it allows the adhesive of the article to remain unaffected until use thereby avoiding premature adhesion to undesired surfaces.

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The applicant acknowledges on page 3 of the instant specification that the Voss reference discloses an adhesive applied to each separate gripping element and that each separate gripping element is then affixed to the outer surface of the tampon (lines 16 – 20). Therefore, the only difference is the use of a release liner which would have been an obvious modification based on the foregoing reasons.

With respect to claims 3 – 4, 6 – 7, 13, 23, 48 – 54 and 56 – 57, see the preceding rejection under Voss in view of Reeves.

Claims 1, 3 – 4, 6 – 7, 13, 23, 48 – 54 and 56 – 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,347,234).

With reference to claim 1, Voss discloses an applicator barrel having an outer surface and a three-dimensional tape connectable to a portion of an outer surface, the tape including a first surface and a second surface opposite the first surface, the first surface having formed thereon at least one integrally formed gripping structure, and a second surface as set forth in figures 2 – 7.

The difference between Voss and claim 1 is the provision that the three dimensional tape is detachably connected to a release liner.

It would have been obvious to one of ordinary skill in the art to provide the tape of Voss with a release liner since it is well known in the art that the use of a release liner is desirable because it allows the adhesive of the article to remain unaffected until use thereby avoiding premature adhesion to undesired surfaces.

The applicant acknowledges on page 3 of the instant specification that the Voss reference discloses an adhesive applied to each separate gripping element and that

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each separate gripping element is then affixed to the outer surface of the tampon (lines 16 – 20). Therefore, the only difference is the use of a release liner which would have been an obvious modification based on the foregoing reasons.

With respect to claims 3 – 4, 6 – 7, 13, 23, 48 – 54 and 56 – 57, see the preceding rejection under Voss in view of Reeves.

Claims 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,575,169) in view of Reeves et al. (US 5,491,015), and further in view of Voss (US 3,347,234).

With respect to claims 16 and 18, Voss ('169) in view of Reeves ('015) does not disclose that the applicator barrel is paper based or plastic. Voss ('234) discloses a tampon applicator that has a gripping structure. Voss ('234) discloses in col. 5, line 62 to the end of col. 5, that the applicator barrel can be made from paper based or plastic materials (as is extremely well known in the art).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the applicator barrel from paper or plastic due to their ease of manufacturing and their easy availability. Paper and plastic based applicators are extremely well known and old in the art and the use of paper or plastic for the barrel material is very obvious to one of ordinary skill in the art.

As to claim 17, Voss ('234) discloses a plastic coating for the paper based blank.

Claims 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,575,169) and further in view of Voss (US 3,347,234).

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With respect to claims 16 and 18, Voss ('169) does not disclose that the applicator barrel is paper based or plastic. Voss ('234) discloses a tampon applicator that has a gripping structure. Voss ('234) discloses in col. 5, line 62 to the end of col. 5, that the applicator barrel can be made from paper based or plastic materials (as is extremely well known in the art).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the applicator barrel from paper or plastic due to their ease of manufacturing and their easy availability. Paper and plastic based applicators are extremely well known and old in the art and the use of paper or plastic for the barrel material is very obvious to one of ordinary skill in the art.

As to claim 17, Voss ('234) discloses a plastic coating for the paper based blank.

Claims 16 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voss (US 3,347,234).

With respect to claims 16 and 18, Voss ('234) discloses a tampon applicator that has a gripping structure. Voss ('234) discloses in col. 5, line 62 to the end of col. 5, that the applicator barrel can be made from paper based or plastic materials (as is extremely well known in the art).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the applicator barrel from paper or plastic due to their ease of manufacturing and their easy availability. Paper and plastic based applicators are extremely well known and old in the art and the use of paper or plastic for the barrel material is very obvious to one of ordinary skill in the art.

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As to claim 17, Voss ('234) discloses a plastic coating for the paper based blank.

Response to Arguments

Applicant's arguments filed June 16, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the use of three dimensional tape on a formed tampon applicator) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The applicants' arguments are directed to a tampon applicator (page 8, 3rd paragraph of the 6/16/04 response), but this language is not commensurate with the claims.

By applicant's own admission, the Voss reference discloses an adhesive applied to each separate gripping element and that each separate gripping element is then affixed to the outer surface of the tampon (lines 16 – 20). Thereby providing a tape with the integrally formed element connected to an adhesive.

The only difference is the use of a release liner which would have been an obvious modification based on foregoing reasons.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 703-308-1412. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michele Kidwell
Examiner
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